

C. Remarks

The claims are 1, 3-7, 16 and 20-22, with claims 1, 16 and 20 being independent. Claims 8-15 have been cancelled without prejudice or disclaimer. No new matter has been added.

The Examiner has required election of a single disclosed invention for prosecution on the merits in this case. The Examiner alleged the existence of three patentably distinct inventions:

- Group I: Claims 1 and 3-7, drawn to a substrate processing method comprising changing the internal pressure of the processing bath when the substrate is dipped in the processing solution, classified in class 134, subclass 17;
- Group II: Claims 8-15, drawn to a substrate processing method comprising adding alcohol to a substrate having a depression, classified in class 134, subclass 26; and
- Group III: Claims 16 and 20-22, drawn to a substrate processing apparatus, classified in class 134, subclass 200.

Applicants provisionally elect Group I, claims 1 and 3-7, with traverse.

The Examiner has stated in the Office Action that the claims of Groups I and III are distinct, but are related. However, under M.P.E.P. §§ 806.06 and 808.02, even if the claims of Groups I and III are distinct, in order to issue a restriction requirement the Examiner must still show that there would be a serious burden imposed if restriction is not required. In fact, absent such a serious burden, “the examiner **must** examine [Groups I and

III] on the merits, even though they include claims to independent or distinct inventions.”

M.P.E.P. § 803 (emphasis added).


Applicants respectfully submit that the Examiner has not shown that a serious burden will result in the absence of the requirement for restriction. This is particularly pertinent, because, as indicated in the outstanding Office Action, the claims of Group I and Group III belong to the same class. Also, a search related to a method of Group I comprising changing the internal pressure of the processing bath when the substrate is dipped in the processing solution is “likely to result in finding art pertinent to” a substrate processing apparatus of Group III that has a pressure control mechanism configured to control internal pressure of the processing bath, as the method of Group I can be practiced by the apparatus of Group III . M.P.E.P. § 808.02.

The Examiner’s explanation of the reasons for restriction on page 2 of the Office Action primarily focuses on the alleged ability of the apparatus of Group III to perform etching. Even if true, this difference alone does not warrant restriction or place a serious burden on the Examiner. The same classification and a field of search, which is likely to yield references pertinent to the claims of both groups, and the related subject matter of the claims, as the features of the apparatus correspond to the performance of the method steps, indicate that a serious burden would not be imposed if restriction is not required.

Accordingly, Applicants respectfully request the Examiner to withdraw the outstanding requirement for restriction and favorably consider all pending claims on the merits, expediently passing the application to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,


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